

### **REMARKS**

The present application includes claims 31-36. Claims 1-30 have been rejected in the present office action. By this response, claims 1-30 have been canceled and new claims 31-36 have been added.

The applicants have carefully considered the official action dated March 5, 2009, and the references it cites and provide the preceding amendments and the following remarks. Reconsideration of the pending claims and previous rejections is respectfully requested.

#### **Subject Matter Rejections**

Claims 15-28 and 30 were rejected under 35 U.S.C. 101 as directed to non-statutory subject matter and under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. By this response, new claims 31-36 have been added to recite gaming machines or methods for use with a gaming machine that rely on a game controller that satisfy both 35 U.S.C. 101 as directed to statutory subject matter and satisfy 35 U.S.C. 112 as being definite. Thus, the applicants respectfully submit that there should be no remaining issues under either 35 U.S.C. 101 or 35 U.S.C. 112.

#### **Art Rejections**

Claims 1-6, 8-11, 13-20, 22-25, and 27-28 have been rejected under 35 U.S.C. 102(b) as anticipated by Gura et al. (U.S. Patent No. 6,270,411). Claims 29-30 have been rejected under 35 U.S.C. 102(e) as anticipated by Vancura (U.S. Patent Application Publication No. 2003/0228897). Claims 7, 12, 21, and 26 have been rejected under 35 U.S.C. 103(a) as unpatentable over Gura in view of Vancura. The applicants respectfully traverse these rejections

for at least the following reasons and respectfully request reconsideration of the rejection of these claims.

Gura relates to a gaming machine with a presentation element that presents a basic game screen and a start animation outcome that activates an animation feature. See, e.g., Abstract. Certain basic game outcomes of the MONOPOLY – CHAIRMAN OF THE BOARD™ game causes the CPU 20 to enter a DICE ROLL mode. See, e.g., col. 4, lines 4-7. The appearance of two or three “DICE” symbols in any position of the reels triggers the animation feature or first screen bonus game termed the DICE ROLL mode. See, e.g., col. 7, lines 23-26. Unlike the base game, the DICE ROLL mode operates in a scatter pay format. See, e.g., col. 7, lines 26-28. Once the DICE ROLL mode becomes active the CPU 20 provides a dice game. See, e.g., col. 7, lines 36-37. Specifically, the CPU 20 randomly selects a dice face value to display for each of the “DICE” symbols. See, e.g., col. 7, lines 37-39. The CPU 20 then animates the “DICE” symbols to display the chosen dice face values. See, e.g., col. 7, lines 41-44. Once the “DICE” symbols have “rolled” and displayed their dice face values in their symbol boxes, the CPU 20 provides an award to the player based on the result of the dice games, namely the displayed dice face values. See, e.g., col. 7, line 66 – col. 8, line 2.

Based on a careful review of the Gura patent, the applicants respectfully submit that Gura only discloses using the appearance of the die symbols on the reels to trigger the DICE ROLL bonus game. See, e.g., col. 7, lines 23-25. Unlike the presently pending claims, Gura does not disclose the additional step of determining whether the exposed faces of the die reveal numbers that meet a criterion for triggering the DICE ROLL feature. That is, Gura will always trigger the feature on the occurrence of the die symbols and independently of the numbers revealed by the die symbols. The numbers revealed by the die symbols in Gura instead determine the value

awarded. Similarly, the card or dice combination of Vancura determines the value awarded itself rather than determining whether the exposed faces of the die reveal numbers that meet a criterion for triggering the DICE ROLL feature.

Claim 31 recited, inter alia, randomly selecting a plurality of numerical values if it is determined that the symbols comprise the die symbols, wherein the game controller is arranged to obtain the numerical values from the die symbols; determine whether the numerical values meet a predefined criterion; and commencing the play of the second game if it is determined that the numerical values meet the predefined criterion. As discussed above, none of these recitations are found in either Gura or Vancura.

For at least these reasons, the applicants respectfully submits that, in view of these missing elements, the cited art fails to disclose the recitations of independent claim 31, nor can the suggested combination of art, in view of the missing elements, render claim 31 *prima facie* obvious. Accordingly, the applicants respectfully submit that independent claim 31 and all claims dependent thereon are in condition for allowance.

Claim 34 recites, inter alia, determining, via the game controller, whether the plurality of symbols comprises a plurality of die symbols; randomly selecting, via the game controller, a plurality of numerical values if it is determined that the symbols comprises the die symbols, wherein the game controller is arranged to obtain the numerical values from the die symbols; determining, via the game controller, whether the numerical values meet a predefined criterion; and commencing, via the game controller, the play of the second game if it is determined that the numerical values meet the predefined criterion.

For at least the reasons described above with respect to claim 31, the applicants respectfully submits that, in view of these missing elements, the cited art fails to disclose the

recitations of independent claim 34, nor can the suggested combination of art, in view of the missing elements, render claim 34 *prima facie* obvious. Accordingly, the applicants respectfully submit that independent claim 34 and all claims dependent thereon are in condition for allowance.

It is respectfully submitted that all pending claims are in condition for allowance, and reconsideration is respectfully requested. The Office is respectfully requested to pass this application to allowance as no combination of the art cited in the official action teaches or suggests the combinations claimed in the pending claims.

**CONCLUSION**

In general, the official action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the applicants will not address such statements at the present time. However, the applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

In view of the foregoing, the applicants respectfully request reconsideration of this application. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Deposit Account No. 50-2455.

Respectfully submitted,

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